REMARKS

Claim Status

Claims 1-34 are pending in the application. Claims 17-20 have been withdrawn from consideration. This paper amends claims 17, 29, and 31; and adds new claims 33 and 34. Claims 1 and 21 are the independent claims of the application that have not been withdrawn from consideration.

Note Regarding Claim Amendment

In the penultimate paragraph of claim 29, the expression "user client" has been replaced with "user_client" to correct a clerical error. The inserted underscore character and underlining coincide, so the amendment may not be clear. It should be noted that "user_client" appears with the underscore character in other (unamended) claims.

Art Rejections

The Office Action rejected independent claims 1 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Diwan, U.S. Patent Number 6,801,936 ("Diwan" hereinafter) in view of Katariya et al., U.S. Patent Publication Number 2002/0091789 ("Katariya" hereinafter). Applicants respectfully traverse the rejections and request reconsideration.

In rejecting claims 1 and 21, the Office Action acknowledged that Diwan does not explicitly disclose "structured document customized according to capabilities of and for delivery to said Internet appliance." The Office Action then sought to supplement this deficiency in Diwan with the teaching of Katariya. According to the Office Action,

> Kat[ariya] discloses receiving user-specific data from the personalization store and receiving data from information providers. The data is rendered to the user according to the personalization data retrieved from the personalization store. The layout of the customized pages are negotiated based on the personalization data (paragraphs [0007, 0033, 0036-0037]).

Office Action, at page 3. The Office Action thus equates personalization of information based on *user-specific data* with customization *according to capabilities* of the Internet appliance. These concept, however, are different.

Capability is a power or capacity for doing something, a facility or potential for indicated use. *See, e.g.*, OXFORD UNIVERSITY PRESS, THE NEW SHORTER OXFORD *ENGLISH DICTIONARY* (CD-ROM ed. 1996) ("Oxford Dictionary" hereinafter); WEBSTER'S COLLEGIATE DICTIONARY (Elec. Ed., Ver. 1.2, 1994-96) ("Webster's Dictionary" hereinafter). Therefore, capability of an Internet appliance is the capacity of the Internet appliance for some indicated use. As described in the specification of the present application, such Internet appliance capabilities may include bandwidth and display capabilities. Specification, page 3, lines 26-31; *id.*, page 12, line 33 through page 13, line 1; and *id.*, page 15, lines 12-17.

In contrast, *user* refers to "one that uses." Webster's Dictionary. In Katariya's context, a user is a user of the computer system and the Internet, and user-specific personalization refers to customization in accordance with such user's data. *See, e.g.*, Katariya, the Abstract ("The computing

- 11 -

system is customizable on a per user basis . . . . The computing system includes . . . personalization

data for a corresponding Internet user.") See also Katariya, numbered paragraphs 0004 and 0005,

which refer to "Internet users" and "user-specific information." Katariya is even more explicit in the

Summary of that document:

> A computing system has been developed that *provides Internet users with a customizable, aggregation of user-specific data, thereby obviating the need for users to endlessly search the WWW for information.* The computing system aggregates information from a number of information providers, such as news services, weather services, stock services, personal email, and even community specific services. Because the information is rendered and aggregated in a user-specific fashion, *each user therefore has a "home" or individual "portal" on the WWW at which the user's most desired information is located.*

Katariya, numbered paragraph 0006 (emphasis added). Therefore, customization of data in Katariya

is performed in accordance with data specific to the individual system or Internet user, which differs

from customization according to capabilities of the Internet appliance, as recited in claims 1 and 21.

Katariya does not disclose customization according to capabilities of the Internet appliance.

Applicants respectfully submit that independent claims 1 and 21 are patentable over Diwan and

Katariya at least for this reason.

Dependent Claims

Dependent claims not specifically discussed above should be patentable together with their

base claims and intervening claims, if any.

New Claims

Applicants believe that new claims 33 and 34 are patentable because the references do not disclose or suggest the combinations of steps recited in these claims.

Note Regarding Withdrawn Claims

The Office Action indicates (on page 2) that claims 17-20 stand rejected as anticipated by Diwan in view of Katariya. Applicants understand this indication to be a clerical error, because claims 17-20 have been withdrawn from consideration. If the rejection of claims 17-20 was in fact intended, Applicants respectfully traverse the rejection.
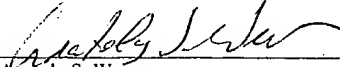
CONCLUSION

For the foregoing reasons, Applicants respectfully submit that all pending claims are patentable over the references of record. To discuss any matter pertaining to the present application, the Examiner is invited to call the undersigned attorney at (858) 720-9431.

Having made an effort to bring the application in condition for allowance, a timely notice to this effect is earnestly solicited.

Respectfully submitted,

Dated: November 4, 2005

Anatoly S. Weiser
Reg. No. 43,229

The Swernofsky Law Group
P.O. Box 390013
Mountain View, CA 94039-0013
(650) 947-0700